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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,541	05/29/2001	Tsunekazu Ishihara	3917-4	4238

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EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/866,541	Applicant(s) ISHIHARA ET AL.	
	Examiner Corbett B. Coburn	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,5,9</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what Claim 3 is claiming. The first memory section is described as being for storage of identification and characteristic data. Then it is described as containing a program that causes identification and characteristic data to be stored in the second storage area. Does the first memory area store both?

3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "the ability data stored" in line 4 and "the read ability data" in line 7. There is insufficient antecedent basis for these limitations in the claim.

4. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 states that the optically readable identification and characteristic data are in a mechanically readable form. Then claim 10 requires that the card reader be an optical reader. Are the data to be optically read? Or mechanically read? It is not clear from the claim, thus rendering the claim indefinite. Examiner assumes that the data is to be optically read.\

5. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 recites the limitation, "capacity data to determine a capacity of the

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sound data and ability data”. What capacity? Volume of the sound recording? Length of the sound recording? Perhaps capacity of the recording medium is indicated – can more sound be recorded? Or maybe capacity (i.e., capability) of the character? The meaning of this limitation is unclear.

6. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 recites the limitation, “the characteristic data recorded includes at least two kinds of data of sound data for generating sound of the character”. In addition to being ungrammatical, the limitation doesn’t make sense. Does it mean two types of sound data? If so, what two types of sound data? Or does the claim mean that the card has at least two of the three types of data listed?

7. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 depends from claim 17. Claim 17 states that the mini-game is based on a program stored in the game information storage medium. Claim 18 says the mini-game is not based on a program stored in the game information storage medium. This is a contradiction. The mini-game may be based on a program stored in the game information storage medium or not based on a program stored in the game information storage medium, but it may not be both. This contradiction renders claim 18 indefinite.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-7, 9, 10, 12, 13, 15-17, 22, 21, 24, 25, 27, 28, 30-33, 35, 36, 38, 44, 46-49, 51, & 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomi (US Patent Number 5,791,988) in view of Garfield (US Patent Number 5,662,332).

Claims 1, 2, 13, 16, 25, 28, 31, 32, 44, 47, 48, 54: Nomi teaches a game system having a plurality of cards (52). The cards visually portray a figure and storing data for use in a card game. The game is played on a computer (Abstract), so it contains a game storage medium storing a game program relating to game card figures. (Col 3, 30-33) The computer also inherently has a processing system for removably receiving therein the game information storage medium. The game machine executes an image display game program that is stored in one memory section. (Col 2, 1-3) The cards store, for each character depicted, identification data and characteristic data relating to a characteristic of an associated character (i.e., each card contains rank and suit). The game system has a game piece reader (Fig 1) for reading the identification and characteristic data from the card. The processing system processes the supplied identification and characteristic data in accordance with the game program stored in a second game program memory section. (Col 1, 60 – Col 2, 11)

Nomi's cards could be considered "character" cards, i.e. each card's suit and value describe a "character". Thus the Jack of Diamonds could be considered a different "character" than the Ace of Spades. This is not, however, how Examiner interprets

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Applicant's claims. The "character" cards described in Garfield appear to be what Applicant intends.

Nomi makes it clear that it is possible to play more than one type of game with the disclosed device. (Col 3, 41-43) Garfield discloses that the game can be implemented on a computer. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the device disclose in Nomi with the game described in Garfield in order to implement Garfield's card game on a computer.

Claim 2: Nomi teaches that the game system can play more than one game (Col 3, 41-42), including games without cards. (Col 3, 16-18) Therefore, when the game system is not supplied with the identification and characteristic data from the card reader, it executes a process on the basis of the game program stored in the game information storage medium thereby executing a different game depending upon whether a game card is used in the game machine.

Claim 3: Nomi teaches a program stored in memory (the first section). In order to play a card game, this program would have to have some information about card identification and characteristics. Nomi teaches that this program registers the card identification and characteristic data when the card reader supplies the information. (Col 4, 6-9) In order to process this information the computer would inherently have to store it into some (second) section of memory.

Claim 4: Nomi teaches the invention substantially as claimed. Nomi teaches a computer that reads and stores in storage sections the identification and characteristic data from

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cards that have such data recorded thereon. (Col 3, 65 – Col 4, 34) There is a program (Col 3, 29-31) that is also stored in a storage section. Nomi teaches reading identification and characteristics data off the card, but does not teach reading other data from the card. Nomi makes it clear, however, that it is possible to play more than one type of game with the disclosed device. (Col 3, 41-43) Garfield discloses a card game in which the card contains additional data other than identification and characteristic data. Garfield discloses that the game can be implemented on a computer. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have read data in addition to identification and characteristic data off of the card in order to implement Garfield's card game on a computer.

Claim 5: Nomi teaches the invention substantially as claimed. Nomi does not, however, teach adding new cards to the game. Garfield teaches a trading card game. (Abstract) One feature of trading card games is that new trading cards are issued from time to time. Garfield teaches that the disclosed trading card game can be implemented on a computer. (Abstract) In order to implement the trading card game on the computer, the computer program would have to be able to process new cards. This would include registering an identification code, ability data and display data of the particular character displayed on the card to a storage area. It would have been obvious to one of ordinary skill in the art at the time of the invention to have a program that registers an identification code, ability data and display data of the particular (new) character displayed on the card to a storage area in order to implement a trading card game in which new cards are issued periodically.

Claim 6: Nomi teaches storing characteristic data of the character recorded in the game card. This characteristic data is the ability data. For example, in certain games, the Jack of Diamonds has the ability to take the Ten of Diamonds. In order to advance the game, the system would inherently have to read the identification data from the card, compare the ability data stored on the card with that stored in the program and advance the game on the basis of the read ability data and the ability data stored in the program. Thus, the system would read in identification/ability data for the Jack of Diamonds, compare it with the identification/ability data stored as part of the program, and since they match, advance the game based on the ability data stored on the card and in the program.

Claims 7, 33, 49, 55: Nomi teaches a game machine using cards to play a game associated with a game program. Nomi does not, however, teach a trading card game. Nomi does teach that different games can be played on the game system. (Col 3, 41-43) Garfield teaches a trading card game including a figure of a character differing in rarity value. (Col 7, 56-58) Garfield also discloses that the trading card game can be implemented on a computer. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have read programmed the game device to play a trading card game in order to implement Garfield's card game on a computer.

Claims 9, 35: Nomi teaches that the processing system displays the card data read by the external reading circuitry. (Col 3, 60) Garfield teaches including text on the card explaining an individual feature of the character. (Fig 1B)

Claims 10, 22, 36, 51: Nomi, Fig 5 (52) shows a game card that records the identification and characteristic data as a two-dimensional array of dots (the diamonds).

The card reader is an optical reader for optically reading the identification and characteristic data. (Col 4, 16-18)

Claims 11, 23, 37: Nomi teaches that the card data may be recorded on non-volatile memory of an IC card (i.e., an embedded microchip) and read therefrom. (Col 3, 21-23)

Claims 12, 24, 38: Nomi teaches that the card data may be recorded magnetically and read by a magnetic reader. (Col 3, 21)

Claim 15: Garfield teaches a game in which the game card includes ability data related to at least to the character. Garfield discloses that this game can be implemented on a computer. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have the processing system change the display of the character in the game based on the ability data read by the card reader in order to implement the game on a computer.

Claim 17: Garfield teaches storing additional data including mini-game data for playing a game based on the game programs stored in the game information storage medium (i.e., duels between wizards (Col 7, 43-45), monster attacks (Col 4, 21-26), etc.).

Claim 21: Nomi teaches an identification code (barcode) on the card. (Col 3, 20-21)

The data stored on the card is, in and of itself, “data for determining the amount of data recorded”.

Claim 27: Nomi teaches cards that store individuality expressing data on an identification-code -by- identification-code basis – i.e., rank and suit data. Nomi has a computer (Fig 1) with semiconductor solid-state memory for storing rank and suit data. The computer is in a case (Fig 5) and is integrally formed with the card reader.

Claims 30, 46, 53: Nomi, Fig 5 shows a hand-held device including a display (76).

10. Claims 8, 14, 19, 20, 34, 50, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomi & Garfield as applied to claims 1, 13, 28, 44, 51 above, and further in view of Doederlien et al. (US Patent Number 5,855,001).

Claims 8, 14, 19, 20, 34, 50, 56: Nomi and Garfield teach the invention substantially as claimed. (Including storing information on the capability of the character and text explaining a feature of the character.) They do not, however, teach that the characteristic data stored on the card includes sound data nor does Nomi teach generating sounds based on this data. Doederlien, another card reader/trading card game, teaches storing sound data on the card and generating sounds based on that data. (Col 1, 63-67) Doederlien teaches that trading cards that contain sound data “provide more information and value than that available from passive sports cards.” (Col 1, 25-28) This in turn increases the demand for the cards. It would have been obvious to one of ordinary skill in the art at the time of the invention to have stored sound data on the card and generated sounds based on that data in order to provide more information and value than that available from passive cards, thus increasing demand for the cards.

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nomi and Garfield as applied to claim 17 above, and further in view of Hollerith cards and Eskildsen (US Patent Number 5,962,839)

Claim 18: Nomi and Garfield teach the invention substantially as described. They do not, however, teach using cards to program the computer. Use of cards to program a computer dates back to the earliest days of computing. The Hollerith card and paper tape

were two of the earliest means of programming a computer. Hollerith cards were often numbered so that they could be rearranged in the proper order. (See the FORTRAN STATEMENT card in the attached reference.) Cards are an inexpensive way to program a computer. It would have been obvious to one of ordinary skill in the art at the time of the invention to have stored program data on the cards (and to put sequence numbers on the card so the data stored thereon could be placed in the proper order) in order to have an inexpensive way to program the computer.

Neither Nomi nor Garfield suggests reprogramming the computer during the ongoing game. Eskildsen teaches a game device that a player can reprogram using barcodes. This allows greater flexibility in presenting a game because the game can be changed depending on the cards played by the player. This adds interest to the game. It would have been obvious to one of ordinary skill in the art to have reprogrammed the ongoing game using the game cards in order to increase game presentation flexibility, thus increasing player interest in the game.

12. Claims 26, 29, 39-43, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomi and Garfield as applied to claims 25, 28, 44 above, and further in view of Bronstein (US Patent Number 4,386,773).

Claims 29, 45: Nomi and Garfield teach the invention substantially as claimed. Nomi teaches that the program may be loaded onto the machine in a number of ways (Col 3, 32-33) but does not specifically teach a game cartridge including processing circuits. Game cartridges are extremely well known in the art. Bronstein provides but one example. Game cartridges are used to prevent software piracy. It would have been

obvious to one of ordinary skill in the art at the time of the invention to have used a game cartridge in order to prevent software piracy.

Claim 39: Nomi and Garfield teach the invention substantially as claimed. Nomi teaches program memory for storing a game program involving cards. (Abstract) Nomi teaches a data reader for reading data from at least one card and processing circuits for processing data read from the card. There is a connector connecting the card reader to the game machine having a processing system for executing a game program. (Fig 1) But Nomi does not teach a removable memory. Game cartridges are extremely well known in the art. Bronstein provides but one example. Game cartridges are used to prevent software piracy. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used a game cartridge in order to prevent software piracy.

Claim 40: Bronstein teaches a cartridge with RAM (32).

Claims 26, 41 & 43: Nomi teaches a groove (78) for receiving at least a portion of the card and reading the card. Nomi does not, however, teach putting the groove on a removable memory cartridge itself. Nomi does, however, teach that the invention may be implemented on a number of different types of computer. (Col 3, 29-36) This would include home video game systems that typically use removable cartridges to store programs and provide specialized circuitry required for the game. Home video games are extremely popular. It would have been obvious to one of ordinary skill in the art at the time of the invention to have mounted the card reader on the removable cartridge in order to implement Nomi's disclosure on a home video game system, thus taking advantage of

the tremendous popularity of these systems. As Bronstein clearly illustrates (Figs 2 & 3), these cartridges contain a semiconductor memory for storing programs and a case accommodating the memory.

Claim 42: Nomi teaches a game machine that executes an image display game program that is stored in one memory section. (Col 2, 1-3) The cards store, for each character depicted, identification data and characteristic data relating to a characteristic of an associated character (i.e., each card contains rank and suit). The game system has a game piece reader (Fig 1) for reading the identification and characteristic data from the card. The processing system processes the supplied identification and characteristic data in accordance with the game program stored in a second game program memory section. (Col 1, 60 – Col 2, 11)

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These are other games and game systems.

Reference Name	US Patent Number
Fujioka et al.	6,270,402
Braunlich et al	6,322,077
Yamada	6,398,651
Domiteaux	5,959,281

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319.

The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's Primary Examiner, Jessica Harrison can be reached on (703) 308-2217. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



cbc

June 13, 2002



JESSICA HARRISON
PRIMARY EXAMINER